

### **REMARKS**

The Examiner is thanked for the thorough examination of the present application. The Office Action mailed November 1, 2006 rejected claims 1-9, and 20-30. This is a full and timely response to that outstanding Office Action. Upon entry of the amendments in this response, claims 1-9 and 20-30 are pending. More specifically, claims 1, 21, and 30 are amended. These amendments are specifically described hereinafter.

#### **I. Present Status of Patent Application**

Claims 1 and 30 are rejected under 35 U.S.C. 112, First Paragraph, as allegedly failing to comply with the written description requirement. Claims 1-2, 4-9, 16, and 20-29 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by *Tsai* (U.S. Patent No. 6,839,741). Claims 3 and 30 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Tsai* (U.S. Patent No. 6,839,741). These rejections are respectfully traversed.

#### **II. Rejections Under 35 U.S.C. §112**

The Office Action rejects claims 1 and 30 under 35 U.S.C. §112, First Paragraph as allegedly failing to comply with the written description requirement. In an effort to address the Examiner's concerns, claims 1 and 30 have been amended to claim "the email message having had all non-text attachments automatically deleted such that the email

message is text only". In view of this amendment, Applicant respectfully submits that the rejection to claims 1 and 30 should be withdrawn.

### III. Rejections Under 35 U.S.C. §102(e)

#### A. Claims 1-2, 4-9, and 20

The Office Action rejects claims 1-2, 4-9, and 20 under 35 U.S.C. §102(e) as allegedly being anticipated by *Tsai* (U.S. Patent No. 6,839,741). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 1**, as amended, recites:

1. A method of manipulating email messages with an email network appliance comprising:  
***receiving an email message with an email network appliance that can only provide the text of a message, the email message having had all non-text attachments automatically deleted such that the email message is text only;***  
classifying the text only email message;  
inserting the text only email message into a classification container; and  
presenting the classification container in a classification display section.  
(Emphasis added).

Applicant respectfully submits that claim 1 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue. See, e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1, as amended, is allowable for at least the reason that *Tsai* does not disclose, teach, or suggest at least

**receiving an email message with an email network appliance that can only provide the text of a message, the email message having had all non-text attachments automatically deleted such that the email message is text only.** Even if, *arguendo*, *Tsai* teaches the removal of attachments from the email message, it fails to teach receiving the email message with an email network appliance that can only provide the text of a message. In *Tsai*, the application is removed for later access by the receiving device. “[R]ecipients of emails still have the ability to view the attachments and can download the attachments, if desired, at their leisure.” See *Tsai*, col. 3, lines 12-14. Therefore, *Tsai* does not anticipate independent claim 1, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 1, as amended, is allowable over the cited references of record, dependent claims 2, 4-9, and 20 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2, 4-9, and 20 contain all the features of independent claim 1. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002); *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2, 4-9, and 20 are patentable over *Tsai*, the rejection to claims 2, 4-9, and 20 should be withdrawn and the claims allowed.

B. Claims 21-29

The Office Action rejects claims 21-29 under 35 U.S.C. §102(e) as allegedly being anticipated by *Tsai* (U.S. Patent No. 6,839,741). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 21**, as amended, recites:

21. A system of manipulating email messages:  
a server configured for receiving a plurality of email messages for a user,  
and for deleting all non-text attachments for all email messages  
received for a user; and  
***a transmitter for transmitting the emails to a user for viewing on an  
email device that can only provide the text of the email  
message.***

(Emphasis added).

Applicant respectfully submits that claim 21 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that independent claim 21, as amended, is allowable for at least the reason that *Tsai* does not disclose, teach, or suggest at least a **transmitter for transmitting the emails to a user for viewing on an email device that can only provide the text of the email message**. Even if, *arguendo*, *Tsai* teaches the removal of attachments from the email message, it fails to teach receiving the email message with an email network appliance that can only provide the text of a message. In *Tsai*, the application is removed for later access by the receiving device. “[R]ecipients of emails still have the ability to view the attachments and can download the attachments, if desired, at their leisure.” See *Tsai*, col. 3, lines 12-14. Therefore,

*Tsai* does not anticipate independent claim 21, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 21, as amended, is allowable over the cited references of record, dependent claims 22-29 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-29 contain all the features of independent claim 21. Therefore, since dependent claims 22-29 are patentable over *Tsai*, the rejection to claims 22-29 should be withdrawn and the claims allowed.

#### **IV. Rejections Under 35 U.S.C. §103(a)**

##### **A. Claim 3**

The Office Action rejects claim 3 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Tsai* (U.S. Patent No. 6,839,741). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

For at least the reason that independent claim 1 is allowable over the cited references of record, dependent claim 3 (which depends from independent claim 1) is allowable as a matter of law for at least the reason that dependent claim 3 contains all the features of independent claim 1. Therefore, the rejection to claim 3 should be withdrawn and the claim allowed.

B. Claim 30

The Office Action rejects claim 30 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Tsai* (U.S. Patent No. 6,839,741). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 30**, as amended, recites:

30. A method of manipulating email messages with an email network appliance comprising:

***receiving an email message with an email network appliance that can only provide the text of a message, the email message having had all non-text attachments automatically deleted such that the email message is text only;***

classifying the text only email message;

inserting the text only email message into a classification container;

presenting the classification container in a classification display section comprising at least two sections, each section containing one classification container;

presenting a text only email message in a classification container, wherein all presenting of the text only email message is performed off-line and

prompting a user to save a sent email message;

wherein the email network appliance comprises a handheld email Internet appliance connected to a public switched network via an RJ-11 interface, the appliance further comprising a keyboard and a scrollable line display capable of presenting at least six lines but no more than fifteen lines.

(Emphasis added).

Applicant respectfully submits that independent claim 30 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features of the claim at issue.

See, e.g., *In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Applicant respectfully submits that independent claim 30 is allowable for at least the reason that *Tsai* do/does not disclose, teach, or suggest at least **receiving an email message with an email network appliance that can only provide the text of a message, the email message having had all non-text attachments automatically deleted such that the email message is text only**. Even if, *arguendo*, *Tsai* teaches the removal of attachments from the email message, it fails to teach receiving the email message with an email network appliance that can only provide the text of a message. In *Tsai*, the application is removed for later access by the receiving device. “[R]ecipients of emails still have the ability to view the attachments and can download the attachments, if desired, at their leisure.” See *Tsai*, col. 3, lines 12-14.

As the cited reference does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 30, the rejection should be withdrawn for at least that reason. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 30 is allowable.

**V. Miscellaneous Issues**

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.



**CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-9 and 20-30 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

It is believed that no extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account No. 20-0778.

Respectfully submitted,

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